

Interview Summary

Application No.

09/691,392

Applicant(s)

KATZ ET AL.

Examiner

James S McClellan

Art Unit

3627

All participants (applicant, applicant's representative, PTO personnel):

(1) James S McClellan (PTO).

(3) David Murphy (Appl. Rep.).

(2) Rocco Adornato (Appl. Rep.).

(4) _____.

Date of Interview: 26 February 2003.

Type: a) ☐ Telephonic b) ☐ Video Conference

c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: 21-25, 34-40, 42 and 43.

Identification of prior art discussed: Fano.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

James S McClellan
Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant submitted support from earlier filed application (US Patent 6,055,513) that expressly supports claims 21, 22, 23, 36, 39, 40, 42, and 43, wherein overcoming the rejections of Fano. Applicant noted that claim 24 related to a GPS will be submitted in independent form because it is not expressly supported by '513. The 112 rejection of claims 37 and 38 will be reevaluated when formal arguments are made to set forth the differences between the two claims. All other objections and 112 rejections will be addressed in the next response.

Draft response for discussion purposes only – Not for formal entry

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)	
Katz, et al.)	Group Art Unit: 3627
Serial No.: 09/691,392)	Examiner: McClellan, J.
Filed: 17 October 2000)	
For: METHODS AND APPARATUS)	Attorney Docket No.: 244/068
FOR INTELLIGENT SELECTION)	
OF GOODS AND SERVICES IN)	
TELEPHONIC AND)	
ELECTRONIC COMMERCE)	

AGENDA FOR INTERVIEW

Examiner McClellan
C/o Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The applicant submits the following as an agenda for discussion during the in-person interview scheduled for Wednesday, 26 February 2003. Attendees include David Murphy, outside patent counsel for West Corporation, Rocco Adornato, in-house patent counsel for West Corporation, and Examiner McClellan of the USPTO.

1. The applicant proposes establishing an earlier effective filing date for certain of the pending claims by claiming priority to the 11 March 1998 filing date of US patent 6,055,513, issued on 25 April 2000. Pending application serial number 09/505,619, filed on 16 February 2000 and entitled "METHODS AND APPARATUS FOR INTELLIGENT SELECTION OF GOODS AND SERVICES IN TELEPHONIC AND ELECTRONIC COMMERCE" provides continuity of prosecution between the '513 patent and the filing date of the application at hand.

2. The applicant includes herewith a claim chart showing support in the specification in the '513 patent for certain of the pending claims. The applicant cites the issued patent by column and line number.

Draft response for discussion purposes only – Not for formal entry

3. The applicant submits that establishing such earlier filing date will effectively remove the Fano and Kolls references for any claims found to have support in the specification of the '513 patent.

The applicant's representatives look forward to the interview on 26 February 2003.

Respectfully submitted,

WEST CORPORATION

Dated: _____

By: _____
Rocco L. Adornato
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Claim Chart Showing Support in Issued US Patent # 6,055,513
for Certain Claims Pending in
Application Serial Number 09/691,392

Claim language in 09/691,392	Support in 6,055,513 patent	Quote from Cited Support
21. A method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communications device, comprising the steps of:	Column 8, lines 35-40	"... methods are provided for effecting ... electronic commerce, which are particularly adapted for the intelligent ... proffer of products, services or information to a user or customer."
	Column 8, lines 49-50	"... utilizing an electronic communications device, ..."
receiving geographical information regarding the geographic position of the user,	Column 9, lines 34-36	"At yet a less specific level of geographic granularity, identification data may include zip code data or other <u>geographic identifier</u> ."
	Column 17, lines 50-54	"In addition to database 98, geographic designator programs exist which may be utilized to receive ANI data and to identify the <u>geographic location</u> of a customer such as by zip code, or more particularly, by zip code plus four."
	Column 21, lines 45-50	"At a lesser level of specificity, namely, one at which a specific user may not be identified, various forms of identification exists. For example, a telephone number may provide <u>geographic indication</u> , such

		as through knowledge of its area code, or provide even more geographic specificity through the prefix. Other geographic descriptors, such as zip code or the finest level of geographic granularity (zip code plus 4) may be utilized."
determining the identity of the user,	Column 8, line 55 Column 12, lines 1-2	"... including determining the <u>identity of the prospective customer</u> ..." "... <u>identity information</u> regarding the user is either automatically obtained such as through the use of ANI or manually obtained, such as through entry of identification information by the user."
utilizing at least in part the geographic position of the user and the identity of the user to determine an offer for a good, service or information, and	Column 12, lines 7-12 Comments: (1) the identity of the user is part of the "primary transaction data" cited above (see Katz '513, column 8, lines 53-56); (2) the geographic position of the user is part of the "second data element" (see Katz '513, column 9, lines 33-37)	"A <u>second data element</u> is then obtained, preferably from a second, and most preferably remote, database which is then used in conjunction with the <u>primary transaction or primary interaction data</u> so as to <u>select a subset of potential of offers</u> of goods, services or information to the user." "obtaining primary transaction data with respect to the transaction, including <u>determining the identity</u> of the prospective customer;" "Optionally, <u>additional data</u> may be requested so as to specify a subset, e.g., a unique resident, from the household. At yet a less specific level of geographic granularity,

		identification data may include zip code data or other <u>geographic identifier</u> ."
offering the item to the user.	Column 8, line 44 (among other support)	"... and thereafter, <u>offer the user</u> or customer one or more items determined to be among the optimum upsells."

<p>22. The method of claim 21 wherein the electronic communication device is a wireless device.</p>	<p>Column 16, line 7 (discussing Figure 3)</p>	<p>"The interconnection 88 between the end instruments 76, 78 may be of any mode or manner, such as a copper wire connection, cable connection, <u>wireless connection</u>, cellular connection, satellite connection, or any other mode or manner of connection."</p>
<p>23. The method of claim 22 wherein the wireless device is a wireless phone.</p> <p>Comment: The applicant submits that the cited portions of Katz support both claims 22 and 23.</p>	<p>Column 20, line 8 (discussing Figure 5)</p>	<p>"A carrier 176, such as an on-line access service, cable access service, network, or other wired or <u>wireless connection</u> may be used to access the desired website 180."</p>

<p>36. The method of claim 21 wherein the offer comprises a coupon.</p>	<p>column 13, line 36;</p>	<p>"When appropriate from context, a good or service may include a <u>coupon</u>, ticket, card or other promotional material, including printed material,</p>
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	<p>column 18, line 8; and</p> <p>column 27, line 16</p>	<p>having a value designator."</p> <p>"The secondary transaction may relate to the offer of a good or a service, or to a <u>coupon</u>, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or a service."</p> <p>"Optionally, an electronic <u>coupon</u> 420 or other form of <u>coupon</u> may be provided to the user in a real time manner for later use. The <u>coupon</u> may be for a discount on a later purchase, or may otherwise be a form of incentive to the customer, such as the award of credits which may be accumulated for exchange into other goods or services."</p>
<p>39. The method of claim 21 wherein the offeror system contacts the user via the electronic communications device.</p>	<p>column 11, lines 35-45</p> <p>column 20, line 55</p>	<p>"In an electronic commerce environment, a display or other communication of the offer is made, such as through textual data, video, and/or audio communication. Additionally, information may be provided by additional or other modes of communication, such as e-mail, facsimile, independent phone contact, cable contact, etc.</p> <p>"In this way, while an initial access</p>

		for a primary transaction is provided to a website, through program flow (where the <u>operator may initiate contact with the user</u>) or at the election of the user (where the user may initiate contact with an operator) 160 may be placed in connection with an operator."
40. The method of claim 21 wherein the determination of an offer is subject to negative decision criteria.	column 24, line 15	"The selection criteria may include <u>negative decision criteria</u> , such as not trying to upsell a customer on an item that the system knows he has previously purchased, or has previously been offered but declined to purchase."
42. The method of claim 21 wherein the offer is made orally to the user.	column 14, line 56	"Typically, a screen pop including a text directed towards the sale of the upsell item would appear, at which point, the telemarketing sales representative would <u>verbally</u> make the sales presentation to the caller."
43. The method of claim 21 wherein the offer is made visually to the user.	column 27, line 4, Figure 9	"A <u>graphical depiction</u> 404 of the good or service may be provided, which is either a still image or includes motion."